

IFW



PATENT
ATTORNEY DOCKET NO. 066079-5085

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Inventors: Alan DICKINSON et al.)	
)	
Application No.: 10/516,496)	Group Art Unit: 2853
)	
Filed: December 1, 2004)	Examiner: Shad, M.S.
)	
For: COMPOSITIONS AND INKS CONTAINING)	
DISAZO DYES)	

Commissioner of Patents and Trademarks
U.S. Patent and Trademark Office
Customer Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

AMENDMENT TRANSMITTAL FORM

1. Transmitted herewith is a Response to the Office Action dated April 23, 2007 in the above-referenced application.
2. Additional Documents
3. Extension of Time

The proceedings herein are for a patent application and the provisions of 37 C.F.R. § 1.136(a) apply.

- ☒ Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.
- ☐ Applicant petitions for an extension of time, the fees for which are set out in 37 C.F.R. § 1.17(a), for the total number of months checked below:

<u>Total Months Requested</u>	<u>Fee for Extension</u>	<u>[Fee for Small Entity]</u>
<input type="checkbox"/> one month	\$ 120.00	\$ 60.00
<input type="checkbox"/> two months	\$ 450.00	\$ 225.00
<input type="checkbox"/> three months	\$ 1,020.00	\$ 510.00
<input type="checkbox"/> four months	\$ 1,590.00	\$ 795.00

Extension of time fee due with this request: \$_____.

If an additional extension of time is required, please consider this a Petition therefor.

- ☐ An extension for _____ months has already been secured and the fee paid therefor of \$_____ is deducted from the total fee due for the total months of extension now requested.

3. Constructive Petition

- ☒ EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).

4. Fee Calculation (37 C.F.R. § 1.16)

CLAIMS AS AMENDED						
	Claims Remaining After Amendment		Highest No. Previously Paid	Present Extra	at Rate of	Total Fees
Total Claims (37 C.F.R. §1.16(c))		minus	20	0	x \$50 each=	+ \$0
Independent Claims (37 C.F.R. §1.16(b))		minus	3	0	x \$200 each=	+ \$0
<input type="checkbox"/> First presentation of Multiple dependent claim(s)					\$360.00	+ \$0
SUB-TOTAL =						\$0
Reduction by 2 for filing by a small entity						- \$0
TOTAL FEE =						\$0

5. Fee Payment


☐ The Commissioner is hereby authorized to charge \$_____ to Deposit Account 50-0310.

☒ The Commissioner is hereby authorized to charge any additional fees which may be required, including fees due under 37 CFR § 1.16 and 1.17, or credit any overpayment to Deposit Account 50-0310.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: May 10, 2007

By: 
Paul N. Kokulis
Reg. No. 16,773

CUSTOMER NO. **09629**
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, NW
Washington, D.C. 20004
202-739-3000



PATENT
Attorney Docket No. 056258-5085

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
)	
Inventors: Alan DICKINSON et al.)	
)	
Appln. No.: 10/516,496)	Group Art Unit: 2853
)	
Filed: December 1, 2004)	Examiner: Shah, M.S.
)	
Title: COMPOSITIONS AND INKS CONTAINING)	
DISAZO DYES)	

RESPONSE TO OFFICE ACTION

Commissioner of Patents and Trademarks
U.S. Patent and Trademark Office
Customer Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is in response to the Office Action dated April 23, 2007.

Reconsideration of the Section 102(a) rejection of claims 1-3 and 6-13 based on newly applied Takimoto JP 2002-020659 is requested. The reference does not anticipate the applicants' invention as discussed below.

Initially, however, it is noted that, while the Examiner has indicated on page 2 of the action that the action is non-final, the paragraph bridging pages 5-6 of the action states that the applicants' prior amendments necessitated the new ground of rejection and that, in the circumstances, the action is made final. This point has been raised by telephone call to the Examiner by counsel and, in telephone message left on May 9, 2007, the Examiner has stated that the intent was to make the action final on the basis stated, i.e. that the applicants' amendment had necessitated the citations new art.

With respect, however, the applicants submit that it is inappropriate to make the action final. The applicants' amendments were not the type that necessitated the citation of the Japanese publication. The applicants' amendments narrowed the original claims. Clearly, if the Japanese reference is relevant against the applicants'

narrowed claims under Section 102 (novelty), the reference should have been citable against the broader original claims. Certainly the Examiner was aware of the reference when the claims were first examined. Thus, the reference is acknowledged in the applicants' specification at page 1, beginning at line 18. The reference was also noted in the applicants' PTO-1449 as filed with the filing of this application. Considering the circumstances, it is respectfully submitted that the action should not be made final on the basis proposed by the Examiner.

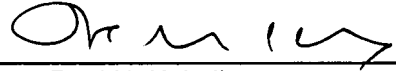
Notwithstanding the foregoing, the applicants submit that it does not matter whether or not the action is made final because it is clear that the Japanese reference does not anticipate the applicants' claims. As explained in the applicants' disclosure at page 1, lines 18-23, Takimoto is concerned with dyes wherein both of the phenyl azo groups attached to the central chromotropic acid group (i.e. the 1,8-dihydroxy naphthalene sulphonic acid group) have a hydroxyl substituted ortho to the azo groups. This is the case in all of the structures of Takimoto referred to by the Examiner on page 3 of the action and clearly different from the applicants' claims. See particularly proviso (i) of claim 1. Furthermore, the structures on pages 4 and 5 of the Office Action are not disazo compounds but, in fact, are monoazo in contrast to the applicants' claims. Thus, Takimoto does not disclose anything claimed by applicants.

Stated otherwise, Takimoto does not disclose compounds having both a 1,8-dihydroxy naphthalene central group and two A groups coupled to it via azo groups, wherein at most only one of the A groups has a hydroxy substituted ortho to the azo groups. This requirement, i.e. that at most only one of the A groups has a hydroxy substituent ortho to the azo groups, is clearly and unequivocally present in the applicants' claims as proviso (i). This clearly distinguishes the applicants' compounds from the Japanese disclosure. See again the compounds listed by the Examiner on page 3 of the action.

Favorable reconsideration with allowance is requested.

Respectfully submitted,

MORGAN LEWIS & BOCKIUS LLP

By 
Paul N. Kokulis
Reg. No. 16773

Date: May 10, 2007

Customer No. 09629

1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
Phone: (202) 739-3000
Facsimile: (202) 739-3001
Direct: (202) 739-5455